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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,388	03/24/2006	Hirokazu Tokuda	2006-0383A	9376

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EXAMINER

FEATHERSTONE, MARK D

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,388	Applicant(s) TOKUDA ET AL.	
	Examiner MARK D. FEATHERSTONE	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 14-20 is/are rejected.
- 7) ☒ Claim(s) 3-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/24/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 18-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 recites "A program list generating program...". A computer program by itself without being embodied on a computer readable medium is not statutory subject matter.

Claim 19 recites "The program list generating program...". Although the claim further indicates that the program is recorded on a computer-readable medium, it is directed to the program itself. Moreover, the computer program must be embodied in a physical computer readable medium. Applicant states that the computer program may be embodied as a "...digital signal transmitted on an electronic communication line, a wireless or wired communications line.." ([0287]). This statement would render any claim directed to a program stored on a computer readable medium non-statutory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Kamen et al, US PG Pub # 20020087985, hereafter Kamen, in view of True, US PG Pub # 20040073922, hereafter True.

With regard to claim 1, Kamen discloses:

A program list generating apparatus for generating a program list ([0012]; Kamen discloses a system for building a program guide), comprising:

An acquiring unit operable to acquire a first title being a title of a first program (Figure 1, item 105 and [0015]; Kamen describes the step of receiving and parsing the title of a first program). Kamen further describes the step (110) of removing nonessential words, and replacing the altered program title in the program guide (125). Kamen fails to disclose the step of displaying the title based on the difference between a first title and second title.

True discloses displaying episodes of the same show along with their subtitles in order to distinguish them from one another. (Figure 6 and [0043]; True teaches that in order to distinguish between different programs having the same title, a further description can be included in the displayed program guide. As illustrated in Figure 6, each episode of Mash is now displayed with a subtitle in order to distinguish it from other episodes of Mash).

It would have been obvious to one of ordinary skill in the art to add the feature as taught by True to include distinguishing information with the title with

the system of Kamen that creates abbreviated titles based on keywords in the title. The resulting title of such a system would be an abbreviated, unique title for each unique program. The advantage of doing this would have been to enable the user to distinguish between different episodes as described by True while fitting the title in a limited space as taught by Kamen.

With regard to claim 2, Kamen, in view of Mash, disclose the program list generating apparatus of claim 1 in that together, they teach a program generating list that lists an abbreviated, unique title for each program. Kamen further teaches the acquiring unit acquires the first and second titles from a program guide which shows information of a plurality of programs (Figure 1, step 105, Kamen describes receiving and parsing the program titles in the program guide)

As described above (claim 1 rejection), True discloses a system for distinguishing between titles. The system of Kamen removes words from titles that are not significant ([0016]; Ramen describes the title "The Big Red House" might be left as "House". In this example, the title "The Big Red Dog" might be left as "Dog"). In this situation, subtitles of the same episode that are part of the program description as taught by True would be abbreviated by the system of Kamen by eliminating the words "The Big Red", to create the distinguishing, abbreviated title.

It would have been obvious to one of ordinary skill in the art to combine these two references in order to create a system that supplies an abbreviated, unique title for each unique program. The advantage of doing this would have

been to enable the user to distinguish between different episodes as described by True while fitting the title in a limited space as taught by Kamen.

With regard to claim 15, Kamen discloses:

a receiving unit operable to receive the first and second programs (Fig. 3, item 302 and [0027]; Kamen describes a broadcast system and a set-top box (item 302) that receives the signals from the network. Kamen further describes the step of receiving and parsing the title of a first program [0015]. Kamen further describes the step (Fig. 1, step110) of removing nonessential words, and replacing the altered program title in the program guide (125). Kamen fails to disclose the step of displaying the title based on the difference between a first title and second title. Kamen fails to disclose a recording unit operable to record the first and second received programs, and an extracting unit that extracts the first difference from the first title, and extracts a second difference from the second title, the first and second differences being respectively portions of the first and second title and being different from each other, and the program list generated by the program list generating unit containing the first and second differences

True describes a recording unit operable to record the received first and second programs ([0066]; True describes a connection to a VCR to control the recording of a program). True further discloses displaying episodes of the same show along with their subtitles in order to distinguish them from one another. (Figure 6 and [0043]; True teaches that in order to distinguish between different

programs having the same title, a further description can be included in the displayed program guide. As illustrated in Figure 6, each episode of Mash is now displayed with a subtitle in order to distinguish it from other episodes of Mash, therefore the displayed titles would be different from each other).

It would have been obvious to one of ordinary skill in the art to add the feature as taught by True to include distinguishing information with the title with the system of Kamen that creates abbreviated titles based on keywords in the title. The resulting title of such a system would be an abbreviated, unique title for each unique program. The advantage of doing this would have been to enable the user to distinguish between different episodes as described by True while fitting the title in a limited space as taught by Kamen.

Claim 17 is the method corresponding to apparatus claim 1, and is rejected as applied.

Claim 18 is the computer program to implement the method steps of claim 17, and is rejected as applied.

Claim 19 is the computer program of claim 18 being recorded in a computer readable recording medium, and is rejected as applied.

Claim 20 is an integrated circuit to perform the steps corresponding to system claim 1, and is rejected as applied. The system as taught by Kamen in view of True inherently contains the circuitry to invoke the steps of the claim.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of True, in further view of Schein, US Patent # 5959688, hereafter Schein.

With regard to claim 14, Kamen, in view of True disclose the program list generating apparatus of claim 2 in that they disclose a system that will generate a programming guide with a list with programming titles and their corresponding channels and times. However, they fail to disclose that the programs are broadcast on different days, on the same channel, and for a same time period.

Schein describes a method that generates a list of multiple programming occurrences of a particular show. Moreover, he teaches that the multiple occurrences of the show can be on the same channel, on different days, and for a same time period (Fig. 3 - Schein shows a view of an EPG that shows several occurrences of a particular show. Two are on the same channel (HBO1), two are on different days (Wednesday and Thursday, as opposed to Monday), and same time period (Figure 2 - Schein shows a view of the EPG that shows the particular time period the show is scheduled for).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Kamen in view of True to allow the user to view all instances of a particular show. The advantage of this would have been to provide the user a convenient way to view all instances of his favorite show.

Allowable Subject Matter

Claims 3-13 are objected to as being dependent on rejected claims. They would be allowable if written in independent form.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose telephone number is (571)270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

E-Signed

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/Mark Featherstone/ - Assistant Examiner

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623